



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,736	11/13/2003	Indran Naick	AUS920030776US1(4015)	2704
45557 7590 03/18/2008 IBM CORPORATION (JSS) C/O SCHUBERT OSTERRIEDER & NICKELSON PLLC 6013 CANNON MOUNTAIN DRIVE, S14 AUSTIN, TX 78749				
EXAMINER				
JEAN GILLES, JUDE				
ART UNIT		PAPER NUMBER		
2143				
MAIL DATE		DELIVERY MODE		
03/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,736

Applicant(s)

NAICK ET AL.

Examiner

JUDE J. JEAN GILLES

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-35, and 37-41 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/2007 has been entered.

Specification

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claims 22-41 are misnumbered because claim 36 is missing. Appropriate correction is requested.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22-35, and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar, U.S. Pub. No. 2002/0019852 A1, in view of Massively et al (hereinafter Massanelli), U.S. Pub. No. 2004/0133645 A1.

Regarding claim 22, Bahar discloses:

A method, in a data processing system for selectively transmitting an email attachment of an email (fig. 2), the method comprising:

selecting, by a sender, email attachment recipients, selectable notification recipients, and excluded recipients for the email to be sent, wherein the excluded recipients do not receive the email attachment (par. 0035; see also abstract);

receiving, from the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients (see par. 0035; see abstract),

transmitting the email to the email attachment recipients, the selectable notification recipients, and the excluded recipients (see abstract. See par. 0035); and

receiving the email attachment by both the selectable notification recipients, who activated the selectable notification, and the email attachment recipients (see abstract. See par. 0035).

Although Bahar teaches substantial features of the invention, Bahar appears not to disclose specifically a system wherein the excluded recipients do not receive the email attachment being part of the selection

process. Nonetheless, this technique would have been obvious combination with the teachings of Bahar to disclose the invention as claimed.

In an analogous art, Massanelli discloses a filtering mechanism for a system's sender to select recipients that should be excluded for receiving an email attachment. Massanelli teaches: "emails and attachments may be compared against the selection criteria to filter the emails and attachments. These selection criteria can include the inclusion or exclusion of emails and attachments having specified: keywords (e.g., vendor names); combinations of words (phrases); recipients or senders (e.g., email addresses or email domain names, internal or external domain names); combination of keywords and phrases; time stamps; conditional expressions; and other fields that may be used to screen emails and attachments for possible relevance to transactions that the system will memorialize. As noted above, the email filtering module 122 preferably includes one or more graphical user interfaces for defining the selection criteria such that the selection criteria can be viewed and changed or updated relatively easily." (see Massanelli, par. 0037).

Accordingly, it would have been obvious for an ordinary skill in the art, at the time the invention was made to have incorporated the teachings of Massanelli with the teachings of Bahar for the purpose of providing "Key features and benefits to a system such as the ability to capture emails and attachment documents based on customized selection criteria..." as stated by Massanelli, par. 0006. By this rationale claims 22 is rejected.

Regarding claims 23-35, and 37-41, the combination Bahar-Massanelli discloses:

22. (New) The method of claim 22, further comprising prompting, in response to activating the selectable notification, to optionally add comments before the selectable notification recipients receive the email attachment (see Bahar, 0038).

23. (New) The method of claim 22, further comprising prompting, in response to activating the selectable notification, the sender to locate the email attachment for the selectable notification recipients before the selectable notification recipients receive the email attachment (see Bahar, 0038, and 0044).

24. (New) The method of claim 22, further comprising receiving, by the excluded recipients, an indication in the email that the email had the email attachment despite the email attachment being unavailable to the excluded recipients (see Massenalli, par. 0037).

26. (New) The method of claim 22, wherein receiving an instruction to add a selectable notification comprises inserting code in the form of a markup language for allowing the selectable notification recipients to receive the email attachment (see Bahar, 0035).

Art Unit: 2143

27. (New) The method of claim 22, wherein receiving an instruction to add a selectable notification comprises inserting, into the email, an icon linked to code for allowing the selectable notification recipients to receive" the email attachment (see Bahar, 0035).

28. (New) The method of claim 22, wherein receiving an instruction to add a selectable notification comprises inserting, into the email, an icon linked to code for allowing the selectable notification recipients to receive the email attachment based on one or more preferences (see Bahar, 0035).

29. (New) The method of claim 22, wherein the selecting the email attachment recipients comprises selecting persons the sender chooses to receive the email attachment with the email and without the selectable notification (see Bahar, 0035, see also abstract).

30. (New) A device in a data processing system for selective transmission of an e-mail attachment for an email (figs. 1, and 2), the device comprising:

an email client for composing the email to be sent to email attachment recipients, selectable notification recipients, and excluded recipients, wherein the excluded recipients do not receive the email attachment (see par. 0035; see abstract);

a notification incorporator, in communication -with the email client, to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients (see par. 0035; see abstract);

a code associator, in communication with the notification incorporator, to associate code with the selectable notification for fetching then email attachment in the email to be sent to the selectable notification recipients (see par. 0035; see abstract); and

another email client for receiving the email attachment by both the selectable notification recipients, who activated the selectable notification, and the email attachment recipients (see par. 0035; see abstract). See also Massanelli, par. 0037 for the specific disclosure of a system wherein the excluded recipients do not receive the email attachment being part of the selection process. The same motivation used or the rejection of claim 22 above is also valid for this claim.

31. (New) The device of claim 30, wherein the notification incorporator prompts a sender at the email client to select the email attachment recipients, the selectable notification recipients, and the excluded recipients (see Bahar, 0038).

32. (New) The device of claim 30, wherein the notification incorporator comprises an icon selector for the selectable notification attachment (see Bahar, 0035).

33. (New) The device of claim 30, wherein the notification incorporator comprises preferences associated with the email attachment (Bahar, 0035, 0038).

34. (New) The device of claim 30, wherein the code associator comprises code

comprising a markup language (see Massanelli; par. 0038, and 0042).

35. (New) The device of claim 30, wherein the code associator comprises a code generator to generate code, upon activation of the selectable notification, in accordance with one or more preferences associated with the email attachment (see Bahar; see also abstract and par. 0038);

37. (New) The device of claim 30, further comprising an attachment responder for prompting a sender before transmission of the email attachment to the selectable notification recipients, who activated the selectable notification (see Bahar, 0038).

38. A machine-accessible medium containing instructions, which when executed by a machine, cause the machine to perform operations for selective transmission of an e-mail attachment for an email, comprising: selecting, by a sender, email attachment recipients, selectable notification recipients, and excluded recipients for the email to be sent, wherein the excluded recipients do not receive the email attachment (see Bahar; figs 1, and 2, see also abstract and par. 0038);

receiving, from, the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients;

transmitting the email to the email attachment, recipients, the selectable notification recipients., and the excluded recipients (see Bahar;, see also abstract and par. 0038); and

receiving the email attachment by both the selectable notification recipients,

who activated the selectable notification, and the email attachment recipients (see par. 0035; see abstract). See also Massanelli, par. 0037 for the specific disclosure of a system wherein the excluded recipients do not receive the email attachment being part of the selection process. The same motivation used for the rejection of claim 22 above is also valid for this claim.

39(New) The machine-accessible medium of claim 38, wherein the operations further comprise instructions for prompting, in response to activating the selectable notification, to add comments and to locate the email attachment before the selectable notification recipients receive the email attachment (see Bahar, 0038).

40. (New) The machine-accessible medium of claim 38, wherein the instructions for receiving an instruction to add a selectable notification comprise inserting, into the email, code in the form of e markup language for allowing the selectable notification recipients to receive the email attachment (see Bahar, par. 0038, 0035).

41. (New) The machine-accessible medium of claim 38, wherein the instructions for receiving an instruction to add a selectable notification comprise inserting, into the email, an icon linked to code for allowing the selectable notification recipients to receive the email attachment optionally based on preferences attachment (see Bahar, 0035).

Conclusion

4. ***This action is made Non-Final.*** Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0800.

Jude Jean-Gilles

/Jude J Jean-Gilles/

Primary Examiner, Art Unit 2143

JJG

March 7, 2008

